

## REMARKS

Claims 1-10 were pending in the present application. By this Amendment, Applicants have canceled claims 3 and 4 without prejudice to their right to present the subject matter of these claims in a future continuation application. Claim 1 has been amended to include a range for the total amount of anti-free-radical agents present. Claims 2 and 5-10 have been amended merely for clarity. Support for the claim amendments can be found throughout the specification and claims as originally filed. Specifically, support for the amendment to claim 1 can be found, *inter alia*, at page 4, lines 8-10 in the specification and in claims 4 and 5 as originally filed. The present Amendment introduces no new matter, and thus, its entry is respectfully requested. Upon entry of the present Amendment, claims 1-2 and 5-10 will be pending and under examination.

### The December 17, 2003 Office Action

#### Claim Rejections under 35 U.S.C. §102

The Examiner rejected claims 1, 2, and 4-6 under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,658,578 (Ogawa, et al.). According to the Examiner, Ogawa, et al. discloses a composition comprising 0.1% by weight magnesium ascorbic acid phosphate, 0.1% by weight of Vitamin E (tocopherol), and 0.1% by weight of panax ginseng extract. The Examiner specifically referred to Example 9, col. 2, lines 11-17. The Examiner asserted that the synergistic effect of the presence of the above antioxidants would be inherent.

The Examiner rejected claims 1-5 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,524,626 (Chen). The Examiner stated that Chen discloses a composition comprising 1% of ascorbic acid, 1% of tocopherol acetate, and 5% by weight of ginseng (panax ginseng) (Example 9). The Examiner also stated that Example 13 discloses 2% of grape seed extract, 1% tocopheryl acetate, and 1% of ascorbic acid. The Examiner asserted that the synergistic effect of the presence of the above antioxidants would be inherent.

Claims 1-6 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,066,327 (Gubernick). According to the Examiner, Gubernick discloses an antioxidant mixture comprising 2% by weight of tocopherol acetate, 0.2% by weight of magnesium ascorbyl phosphate, and 0.1% by weight of rosemary extract. The Examiner asserted that the synergistic effect of the presence of the above antioxidants would be inherent.

In response, without conceding the correctness of the Examiner's position, but to expedite allowance of the subject application, Applicants have amended claim 1. None of the references cited by the Examiner (Ogawa, Chen, or Gubernick) discloses a topical cosmetic composition for application to the skin, said composition comprising a suitable diluent or carrier in combination with a synergistic mixture of three anti-free-radical agents each of which is selected from a different member of the group consisting of (a) ascorbic acid, its salts, and/or esters; (b) morus alba, (c) origanum vulgare, (d) panax ginseng, (e) rosmarinus officinalis, and (f) grape seed oil, wherein the total amount of anti-free-radical agents present is in the range 0.001 to 5% by weight. Therefore, the claims as amended are not anticipated by the references cited by the

Examiner. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections of claims 1-6 under 35 U.S.C. §102.

Claim Rejections Under 35 USC §103

Claims 6-10 were rejected under 35 U.S.C. §103 as being obvious over Chen, in view of Gubernick. The Examiner indicated that Chen teaches compositions comprising ginseng and morus alba and generally refers to combining herbal and plant ingredients to provide various vitamins. The Examiner acknowledged, however, that there is no mention of magnesium ascorbyl phosphate, sodium ascorbyl phosphate, rosmarinus officinalis, or origanum vulgare, as recited in part (c) of Applicants' claim 7. The Examiner further indicated that Gubernick teaches that rosemary extract is a well-known antioxidant in cosmetic art, used in the amounts recited in Applicants' claims. According to the Examiner, it therefore would have been obvious to modify the composition of Chen by adding rosemary extract "as motivated by Gubernick" because of the expectation of successfully producing a cosmetic composition with enhanced antioxidant properties.

In response, Applicants respectfully traverse the Examiner's rejection. Applicants point out to the Examiner that Gubernick teaches compositions requiring a combination of at least five specific antioxidants for effectiveness. There is simply no motivation in the cited references to select a particular one of these, i.e., rosemary extract, and add it to the compositions referred to in

Chen, with a reasonable expectation that it would provide any benefit. Accordingly, Applicants' claims 6-10 are not obvious over the references cited by the Examiner.

Claims 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gubernick, in view of Meybeck (U.S. Patent No. 5,164,182). The Examiner acknowledged that although Gubernick teaches antioxidant mixtures in cosmetic and skin compositions, it fails to specifically mention morus alba (mulberry extract). The Examiner noted that Meybeck teaches using mulberry extract as a skin-lightening and anti-inflammatory agent. In the Examiner's opinion, it therefore would have been obvious to one of skill in the art to modify the Gubernick antioxidant compositions by adding mulberry extract.

In response, Applicants respectfully traverse the Examiner's rejection of claims 7-10. In that regard, Applicants point out that the Meybeck reference teaches that mulberry extract surprisingly shows enhanced activity only within the context of particular uses, i.e. when "incorporated into a hydrated lipidic lamellar phase or into liposomes." (Col. 2, lines 66-67). Gubernick does not refer to such uses. Accordingly, one would not be motivated to modify Gubernick with the addition of mulberry extract based on the teachings in Meybeck, because doing so would not appear to offer any benefit. Therefore, claims 7-10 are not rendered obvious over the references cited by the Examiner.

Moreover, Applicants attach hereto a Data Sheet which includes results showing that combinations of agents as recited in the claims have an unpredictable synergistic effect which is not suggested by the above prior art, taken either alone or in combination. If the Examiner would prefer to see this data in the form of a Rule 132 Declaration, the Examiner is invited to please

telephone the Applicants' undersigned attorney, who will be pleased to submit such a Declaration for consideration.

The attached Data Sheet first describes measurements of the efficacy of combinations of anti-free radical agents which fall within the scope of amended Claim 1 in inhibiting free radical mediated lipid peroxidation. The method used is as described at pages 50-51 of the present specification.

The results obtained are shown in graphical form on pages 2, 3, and 4 of the Data Sheet, and it is apparent that for the fourteen different combinations of anti-free radical agents shown (and listed on page 5) there is a synergistic, supra-additive effect. Many of these combinations were tested again in a separate series of experiments. The results are set out in Table II (page 5), which compares the predicted (additive) effect of the components of the mixture with that actually measured. Again, it can be seen that the actual effect is consistently greater than that which would be expected.

Finally, an *in vivo* comparison was made, using the methodology described on page 52 of the specification, of the effect of a combination of ascorbyl phosphate/morus alba (mulberry)/ginseng with the individual components. Again, a synergistic, supra-additive effect is observed.

An unpredictable and unexpected, synergistic effect clearly has been demonstrated for a representative number of combinations of anti-free radical agents falling within the scope of the amended claims. In view of these results, and the remarks set forth above, Applicants believe that the claims, as amended, are not obvious over the art cited by the Examiner. Accordingly,

Applicants respectfully request that the Examiner reconsider and withdraw the claim rejections under 35 U.S.C. §103.

Examiner's rejection based on Double Patenting

The Examiner provisionally rejected claims 1-10 under the judicially created doctrine of obviousness-type double patenting, as being obvious over claims 1-13 of copending Application No. 10/030147.

In response, Applicants' Attorney requests this rejection be held in abeyance until a proper terminal disclaimer pursuant to 37 C.F.R. 1.321 and 3.73(b) is obtained and filed in a supplemental response to this Office Action. It is believed that a terminal disclaimer will overcome the double patenting rejection.

In view of the above remarks, amendments, and attached Data sheet, Applicants believe that the Examiner's rejections set forth in the December 17, 2003 Office Action have been fully overcome and that the present application is in condition for allowance. The Examiner is invited to telephone the undersigned if it is deemed to expedite allowance of the application.

Respectfully submitted,



Date: June 17, 2004

Patrick T. Skacel  
Registration No. 47,948  
Attorney for Applicants  
Rothwell, Figg, Ernst & Manbeck, P.C.  
1425 K Street, N.W., Suite 800  
Washington, DC 20005  
Telephone: (202) 783-6040  
Fax: (202) 783-6031